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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/501,315

02/09/2006

Ban Chin To

105SR-019

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32192

7590

12/24/2008

BRADLEY N. RUBEN

503 MITCHELL COURT

CHAMPAIGN, IL 61821-3535

EXAMINER

MAKIYA, DAVID J

ART UNIT

PAPER NUMBER

2885

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DELIVERY MODE

12/24/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/501,315	<b>Applicant(s)</b> TO, BAN CHIN	
	<b>Examiner</b> David J. Makiya	<b>Art Unit</b> 2885	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 34-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/29/2008 has been entered.

#### ***Claim Objections***

Claim 43 is objected to because of the following informalities: it is unclear as to how the facia retainer can be connected to an intermediate member, if the facia retainer is connected directly "for holding the front facia in position in the support surround," not in an intermediate member. Claims will be interpreted as best understood. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34-42 and 49-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caluori (US Patent 5,609,414) in view of Houplain (US Patent 4,763,231).

With respect to claims 34, 36, and 52-56, Caluori teaches a light fitting having a front and a rear, the light fitting having a support surround 14 and a front facia 24, and a facia retainer

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26 for holding the front facia in position in the support surround (Column 3, Lines 19-21), the facia retainer being resilient for enabling removal (Figure 2) thereof from an installed position (Figure 1) thereof by a generally translational movement (Figure 1; Column 1, Lines 15-20), the light fitting further having a lamp retainer 24 and a lamp 2 wherein the lamp is retained by the lamp retainer (Figure 1), the facia to enable a finger or a tool to be engaged behind a ledge (overlap of 24 past 16; Figure 1) to facilitate removal of the front facia from the support surround (Column 3, Lines 11-21 and Column 5, Lines 13-15).

However, Caluori fails to teach the lamp being resiliently biased toward the rear side of the front facia such that the lamp may be moved backwards away from a recessed ledge of the rear side of the front facia.

Houplain teaches a light fitting comprising a support surround 1 and a front facia 6 and a facia retainer 8, the facia retainer being resilient for enabling removal thereof from an installed position (Figure 5) at the front of the light fitting by a generally translational movement (Figure 2; Column 2, Lines 36-51), the light fitting further having a lamp retainer 17 and a lamp 11 wherein the lamp is retained by the lamp retainer (Column 2, Lines 60-64), the front facia has a rear side and a front side (Figure 2), and a tube 20 extending axially in front of the lamp (Column 3, Lines 5-15) the lamp being resiliently biased (15; Column 2, Lines 54-63) toward the rear side of the front facia such that the lamp may be moved backwards away from a recessed ledge 17 of the rear side of the front facia (Column 3, Lines 3-4) that engages the perimeter of the lamp (Figure 5) to enable a finger or a tool to be engaged behind the ledge to facilitate removal of the front facia from the support surround (Column 2, Lines 36-60), in which the resilient biasing is provided by two helical springs 15 for biasing the lamp towards the front facia (Column 2, Lines

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54-63), each extending from an end 16 of a lamp opposite a lens end 24 thereof to a lamp retainer 16 and from an electrical connector (12, 13, 14) to the lamp retainer (Column 2, Lines 54-63).

It would have been obvious and advantageous to one of ordinary skill in the art at the time of the invention to modify and reconstruct the light fitting of Caluori by adding helical springs to resiliently bias the lamp toward the front facia because they “makes it possible to hold the lighting fixture 11 together with the support 6 by means of two springs 1” (Houplain; Column 2, Lines 54-63) to ensure the electrical contact of the lamp to the socket 12.

With respect to claim 35, Caluori teaches the light fitting in which the lamp retainer forms the front facia (Figure 1).

With respect to claims 37-40, Caluori in view of Houplain teaches the light fitting as described above.

However, Caluori in view of Houplain fails to teach a particular shape for the front facia to have a non-circular cross section.

It would have been obvious and advantageous to one of ordinary skill in the art at the time of the invention to modify and reconstruct the cross sectional shape of the front facia of Caluori in view of Houplain with any shape, since it has been held by the courts that a change in shape or configuration, without any criticality, is nothing more than one of numerous shapes that one of ordinary skill in the art will find obvious to provide based on the suitability for the intended final application *In re Dailey*, 149 USPQ 47 (CCPA 1976) and a simple substitution of one known element for another would have yielded predictable results to one of ordinary skill in

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the art at the time of the invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. -, 82 USPQ2d 1385. It appears that the disclosed device would perform equally well shaped as disclosed by Caluori.

With respect to claim 41, Caluori teaches the light fitting in which the support surround includes at least one spring arm (40; Column 3, Lines 26-31) for holding the light fitting in place on a layer of building material 3.

With respect to claim 42, Caluori teaches the light fitting in which the front facia is directly retained by the facia retainer to the support surround (Column 3, Lines 19-21).

With respect to claim 49, Caluori teaches the light fitting in which the facia retainer comprises at least one spring clip (Column 3, Lines 19-21).

With respect to claim 50, Caluori teaches the light fitting in which a pair of said spring clips 40 is provided, located on opposed sides of the light fitting (Figure 1).

With respect to claim 51, Caluori teaches the light fitting in which each spring clip 26 is secured to the front facia (Figure 1; Column 3, Lines 19-21).

With respect to claim 57, Caluori teaches the light fitting which includes a lamp 92, the lamp having a flat front surface (Figure 1).

With respect to claim 58, Caluori teaches the light fitting which comprises a downlighter (Column 1, Lines 10-15).

Claims 43-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caluori in view of Houplain as applied to claim 34, and further in view of Zadeh (US Patent 5,548,499).

With respect to claims 43 and 44, as best understood, Caluori in view of Houplain teaches the light fitting as described above.

However, Caluori in view of Houplain fails to teach the front facia attached by the facia retainer to an intermediate member.

Zadeh teaches a light fitting having a front and a rear, the light fitting having a support surround 10 and a front facia 34, and a facia retainer 62 in which the front facia is attached by the facia retainer to an intermediate member 60, the intermediate member being pivotally connected to the support surround (Column 3, Lines 33-47).

It would have been obvious and advantageous to one of ordinary skill in the art at the time of the invention to modify and reconstruct the light fitting of Caluori in view of Houplain by adding the pivotally connected intermediate member from the teachings of Zadeh because “the lamp pivotally mounted so that its light may be directed at a plurality of angles relative to the ceiling” (Zadeh; Column 1, Lines 38-42).

With respect to claims 45-48, Caluori in view of Houplain and Zadeh teaches the light fitting as described above.

However, Caluori in view of Houplain and Zadeh fails to teach a particular shape for the front facia to have a non-circular cross section.

It would have been obvious and advantageous to one of ordinary skill in the art at the time of the invention to modify and reconstruct the cross sectional shape of the front facia of Caluori in view of Houplain and Zadeh with any shape, since it has been held by the courts that a change in shape or configuration, without any criticality, is nothing more than one of numerous shapes that one of ordinary skill in the art will find obvious to provide based on the suitability for the intended final application *In re Dailey*, 149 USPQ 47 (CCPA 1976) and a simple substitution

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of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. -, 82 USPQ2d 1385. It appears that the disclosed device would perform equally well shaped as disclosed by Caluori.

### ***Response to Arguments***

Applicant's arguments with respect to claims 34-58 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's arguments regarding Caluori, the applicant is referred to Column 1, Lines 15-20, Column 3, Lines 11-21, and Column 5, Lines 13-15. Each is referred to for reference to "the housing trim 24," which as shown in Figure 1 and the related specification, is equivalent to the applicant's claimed "front facia."

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wyatt (US 2007/0147052) and Thompson et al. (US Patent 7,217,008) teach light fittings with pivoting members.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Makiya whose telephone number is (571) 272-2273. The examiner can normally be reached on Monday-Friday 7:30am - 4:00pm (ET).



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jong-Suk (James) Lee can be reached on (571) 272-7044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DJM/  
12/19/2008

/Jong-Suk (James) Lee/  
Supervisory Patent Examiner, Art Unit 2885